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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,091	06/15/2001	Kiril A. Pandelisev	PHOENIX SCIENTIFIC	7262
	7590	02/23/2004	EXAMINER	
James C. Wray Suite 300 1493 Chain Bridge Road McLean, VA 22101			HOFFMANN, JOHN M	
			ART UNIT	PAPER NUMBER
			1731	
DATE MAILED: 02/23/2004				

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EXAMINER

ART UNIT	PAPER
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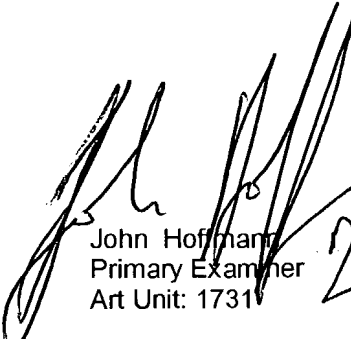
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Commissioner for Patents

Notice of Non-Responsive Amendment

(See attached Sheets)


John Hoffmann
Primary Examiner
Art Unit: 1731 2-17-04

The amendment filed on 26 January 2004 presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention because claim 65 has been amended to directing particles toward the substrate. In the election of 07 July 2003, Applicant elected species E1: the MCVD method. In the search to find the most relevant art, Examiner focused on prior art MCVD methods. In the MCVD method, particles are not directed to the substrate, because the particles are created within the substrate. It is in the OVD and VAD methods and planar deposition where particles are directed toward the substrate: these are species E2, E3, and E5 which applicant did not elect. These species require searches in at least 65/386, 65/421, 65/414, 65/415 which were never searched. It would be an undue burden for the Office to now examine an entirely different and mutually exclusive species.

As stated in MPEP 819: "The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter."

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

Examiner notices that claim 65 is now somewhat similar to original claim 73. However, claim 73 was indefinite, and was the directing of particles aspect was not searched, examined, or treated because Examiner could not tell what it what it was suppose to mean. Applicant failed to provide a complete list of the claims directed to the elected invention, and Examiner had to make his best guess as to what Applicant intended.

Also from MPEP 819: Where the inventions are distinct and of such a nature that the Office compels restriction, an election is not waived even though the examiner gives action upon the patentability of the claims to the nonelected invention. Ex parte Loewenbach, 1904 C.D. 170, 110 O.G. 857 (Comm'r Pat. 1904) and *In re Waugh*, 135 F.2d 627, 57 USPQ 371 (CCPA 1943).

Examiner interprets this to mean - it does not make a difference whether the Office examined a claim directed to a non-elected invention. The election is not waived.

Arguments (filed 26 Jan 2004) regarding the original requirement have been considered. They are not persuasive. It is argued that the examiner did not consider "as claimed" in restricting claim groups II and I. Examiner is interpreting this argument as: Examiner ignored some limitation(s). Examiner gave full weight to all the claim limitations. Examiner is further guessing that Applicant's point is the present claim 1 "for making a preform in a chamber", and it is not for coating a metal part. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The present claim 1: has an

intended use "for making fused silica products". This does not require any structural difference. The claim 65: "for making a fiber optic preform" does require the creation of a preform (as Applicant argues) and but no where does examiner suggest otherwise. By looking at burner, it is impossible to tell one is going to be coated, or what the coating composition will be. Applicant's argument suggests that one can tell what the coating and the to-be-coated item are. But there is no argument or evidence that this is true. Any mere allegation is insufficient.

As to group III, "in spite of the fact that a product-by-process claim may recite only process limitations, it is the product which is covered by the claim and not the recited process steps." (In re Hughes, 182 USPQ 106). To put it another way, when looking at applicant's product (or another glass preform made by another process), it is impossible to tell if it is made by Applicant's process or by another process. Again, any mere allegation to the contrary is insufficient.

As to the allegation that the Office failed to make a showing of distinctiveness and undue burden: As indicated previously a prima facie showing of undue burden has been established in accordance with MPEP 803 which states in part:

"For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02."

In other words, Examiner has established a prima facie showing of a serious burden as per the requirement of 5-15-2003.

As to a prima facie showing of distinctness - such is also provided in the requirement of 5-15-2003 in accordance with MPEP 806.5.